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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	
GILBERT P. HYATT	Group Art Unit 2188
Serial No. 06/848,017	Examiner: Reginald Bragdon
Docket No. 307	
Filed: April 3, 1986	
For: AN INTEGRATED CIRCUIT FILTER PROCESSOR	

REQUEST FOR WITHDRAWAL OF AN IMPROPER RESTRICTION REQUIREMENT

Hon. Commissioner For Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Sir:

The Applicant respectfully requests that the examiner withdraw an improper restriction requirement in the February 3, 2004 Action and generate a supplemental Action directed to all of the claims presented for examination under 37 CFR 1.111.

I. THE EXAMINER WITHDRAWS PREVIOUSLY EXAMINED CLAIMS, ERRONEOUSLY ALLEGING THAT THEY ARE NON-ELECTED

The prior examiner **examined** claims 5 and 41-97, including claims 53-58 which recite digital signal processor and integrated circuit claim limitations. However, the present examiner then restricted and withdrew **examined** claims 57-58, erroneously alleging that claim 57-58 and other digital signal processor and integrated circuit claims are constructively non-elected (paragraph 8). The Examiner offers no reason how **previously**

examined claims **can somehow become** constructively non-elected after being examined, and the Applicant knows of no such reason.

For this reason alone (improper constructive election), the restriction requirement **must** be withdrawn.

Further, the Examiner offers no reason how digital signal processor and integrated circuit claims 53-56 can be constructively elected while similar claims 57-58 can be constructively **non**-elected

Further, currently elected and examined claims 53, 56, 116, and 118 expressly recite (and thereby at least link) integrated circuit and digital signal processor claim limitations. For this additional reason (linking claim limitations), the other claims reciting these limitations should be examined.

II. THE RESTRICTION REQUIREMENT IS FATALLY DEFECTIVE

The restriction requirement is fatally defective and must be withdrawn for the most basic of reasons. The subject matter restricted was previously examined by virtue of the previous examiner's examination of claims 53-58 in the Office Action dated September 28, 2001. There, the examiner examined claims focused upon and directed to digital signal processor and integrated circuit limitations. Further, the restriction requirement disregards the essential independence requirement. Still further, the Examiner's comments on distinctness constitute unsupported conclusory statements. Yet further, as discussed above, currently elected and examined claims 53, 56, 116, and 118 expressly recite (and thereby at least link) integrated circuit and digital signal processor claim limitations. These are in addition to the erroneous constructive election (discussed above). Hence, the restriction requirement does not even come close to satisfying PTO requirements for supporting restriction.

III. THE EXAMINER IS JUDICIALLY ESTOPPED FROM MAKING THE INSTANT RESTRICTION REQUIREMENT

The Examiner is judicially estopped from making the instant restriction requirement. Judicial estoppel is an equitable principle that holds a party to a position on which it has prevailed, as against later litigation arising from the same events. Eagle Foundation Inc. v. Dole, 813 F.2d 798, 810 (7th Cir. 1987). By analogy, the Examiner here is estopped from restricting the claims in light of the examination of the claimed subject matter in the action of September 28, 2001.

> "Where a party assumes a certain position in a legal proceeding, and succeeds in maintaining that position, he may not thereafter, simply because his interests have changed, assume a contrary position."
> Davis v. Wakelee, 156 U.S. 680, 689 (1895). See also U.S. Philips v. Sears Roebuck & Co., 55 F.3d 592, 596, 34 USPQ2d 1699, 1703 (Fed. Cir. 1995).

As the Federal Circuit explained in Sears, judicial estoppel is designed to preserve the integrity of the judicial process by "protecting against litigants who 'play fast and loose with the courts.'" id at 1703. The Examiner's restriction, constructive election, and withdrawal is contrasted with the prior examiner's examination of the then-elected claims 53-58 and with the current examiner's examination of currently elected and examined claims 53, 56, 116, and 118 which recite integrated circuit and digital signal processor claim limitations (discussed above). This constitutes playing fast and loose with the law and with the PTO guidelines under which he is required to operate. Also, the erroneous restriction requirement (discussed above) further constitutes playing fast and loose with the law and with the PTO guidelines under which he is required to operate.

The erroneous restriction requirement is further discussed below.

The restriction requirement mentions "independent **or** distinct" (instant Action at page 2) (emphasis added) and then proceeds to discuss "distinct" while disregarding "independent". This violates 35 USC 121. 35 USC 121 states:

> 35 U.S.C. 121 Divisional applications.
> If two or more independent **and** distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. (emphasis added)

There can be no question that the Examiner must address both, independence **and** distinctness. The Applicant has a right to a determination of "independent and distinct" as required by 35 USC 121.

The PTO requires an examiner to demonstrate two-way distinctness regarding combinations and subcombinations.

> "In order to establish that combination and subcombination inventions are distinct, **two-way** distinctness **must be demonstrated.**" [emphasis added] (MPEP 806.05(c))

However, the Examiner has not even "demonstrated" one-way distinctness, relying only on an unsupported conclusory statements and dubious classifications, and the Examiner certainly has not "demonstrated" two-way distinctness. Unsupported conclusory statements do not constitute a **demonstration.**

The PTO is very specific about the meaning of combination and subcombination terminology, but the Examiner disregards the PTO requirements related thereto. The PTO defines:

> "805.06(a) Combination and Subcombination or Element
> A combination is an organization of which a subcombination or element is a part."
> (MPEP 805.06(a))

Hence, a subcombination is an element or a part of a combination. **This is contrary to the Examiner's position.** The Examiner alleges that Group I and Group II (as well as other group pairs -- see action pages 3-5) are related as subcombinations disclosed as usable together in a single combination. This statement is not otherwise explained. However, the Examiner does not attempt to

show that the claims have the necessary combination/subcombination relationship. This is not surprising, the claims do not have a combination/subcombination relationship. The Examiner merely relies on unsupported conclusory statements without making the required showing.

IV. THE EXAMINER'S ATTEMPT TO ESTABLISH DISTINCTNESS IS FATALLY DEFECTIVE

The restriction requirement is improper because it does not establish that the inventions are distinct. The Action merely makes unsupported conclusory statements regarding "distinctness". The classifications are dubious; e.g., they appear to be an effort to justify restricting of the already examined digital signal processor technology (see claims 53-58).

The Action does not give any reasonable guidance as to why the claims are alleged to be distinct. The arguments are self serving and conclusory.

Regarding combinations and subcombinations, the PTO requires an examiner to demonstrate two-way distinctness.

> "In order to establish that combination and subcombination inventions are distinct, **two-way** distinctness **must be demonstrated.**" [emphasis added] (MPEP 806.05(c))

However, the Examiner has not even "demonstrated" one-way distinctness, relying only on unsupported conclusory statements, and the Examiner certainly has not "demonstrated" two-way distinctness. Unsupported conclusory statements do not constitute a **demonstration.**

The PTO requires a **showing** for **patentability.**

> "If it can be **shown** that a combination, as claimed (1) does not require the particulars of the subcombination as claimed **for patentability** (to show novelty and nonobviousness) ..." [emphasis added] (MPEP 806.05(c))

However, the Examiner has not provided such a "showing", only

unsupported conclusory statements, and the Examiner has certainly not provided a showing "for patentability". In view of the restriction, the Examiner would not be able to support an allegation that "the particulars of the subcombination" are not required for patentability.

The Action falls far short of establishing two-way distinctness and of providing reasons for insisting on restriction with the unsupported conclusory and erroneous statements presented on this record.

V. THE CLASSIFICATIONS ARE DUBIOUS

Since the digital signal processor invention was previously examined in claims 53-58, the creative classification that places four of the ten groups in the same class and subclass and seven of the ten in the same class does not justify restriction. Essentially, the examination of the subject matter has been done. These various groups (other than group I) all embrace digital signal processors allegedly found in class 712, subclass one (processing architecture). How burdensome can it be for the current examiner to examine already examined subject matter? Variations in claim breadth or scope does not constitute an evidentiary basis for restriction. It could reflect a change in classification but classification does not stand as a basis for restriction or for restricting already examined subject matter. The classifications are thus very suspect to the extent they are used to justify restriction.

VI. THE RESTRICTION REQUIREMENT DOES NOT PROPERLY CONSIDER LINKING CLAIMS

Despite the impropriety of the restriction requirement (discussed above), the Examiner did not properly consider linking claim limitations. Certainly, the examined claim limitations of digital signal processor, integrated circuit processor, and single chip integrated circuit processor constitute linking claim limitations, where the claims reciting these limitations must be examined.

Further, as discussed above, currently elected and examined claims 53, 56, 116, and 118 expressly recite (and thereby at least link) integrated circuit and digital signal processor claim limitations. For this additional linking claim reason, the other claims reciting these limitations should be examined.

VII. EQUITABLE ISSUE

The Applicant proposed all of the restricted and withdrawn claims in amendments dated between July 25, 1990 and May 6, 1998. The prior examiner examined part of this amendment but apparently inadvertently did not examine all of these amendments in his subsequent Action dated September 28, 2001. The Applicant's representative called the prior examiner and the prior examiner said that the May 6, 1998 amendment was not in the file, he asked for a copy of the amendment, and he indicated that he would consider the amendment upon receipt. See the Telephone Conference Record dated January 4, 2002. However, the prior examiner was replaced by the current examiner who took a more limited position regarding examination. Thus, if it had not been for the prior examiner's inadvertent error, claims 98-351 would likely have been examined with claims 5 and 41-97.

VIII. RELIEF REQUESTED

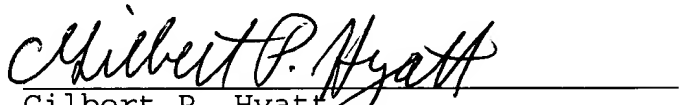
The Applicant respectfully petitions for withdrawal of the improper restriction requirement and for an action directed to all of the claims presented for examination.

Please charge any fees associated with the papers transmitted herewith to Deposit Account No. 08-3626. A Declaration claiming small entity status has been filed herein.

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with the express mail label number EV 323875898 on October 7, 2004.

Respectfully submitted,

Dated: October 7, 2004



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